

D. Remarks

Objections to the Specification

The title has been amended to address this objection.

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Rejection of Claims 21 and 26 Under 35 U.S.C. §102(b) based on *Fedeli* (USP 6,542,060).

The semiconductor integrated circuit of amended claim 21 includes an inductor on a substrate and a laminated film beside the inductor. The laminated film has a ferromagnetic substance layer and a metal layer covering the ferromagnetic substance layer to prevent diffusion of the ferromagnetic substance layer.

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As is well known, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference. Because the reference *Fedeli* does not show all elements of amended claim 21, this ground of rejection is traversed.

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Fedeli discloses an inductor having a ferromagnetic layers separated by a spacer layer. The spacer layer can be a metal spacer layer, such as copper.¹ The spacer layer has a thickness that allows the ferromagnetic layer to be antiferromagnetically coupled so that magnetoresistance is at a peak.² *Fedeli* does not disclose or suggest a laminated film having a ferromagnetic substance layer and a metal layer covering the ferromagnetic substance layer to prevent diffusion of the ferromagnetic substance layer as required in amended claim 21.

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For these reasons, the rejection of claim 21 is traversed.

Claim 26 depends from claim 21, which is believed to be allowable.

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Rejection of Claim 27 Under 35 U.S.C. §103, based on *Fedeli* in view of *Shiga* (5,396,101).

The semiconductor integrated circuit of claim 27 depends from claim 26 which depends from amended claim 21.

The semiconductor integrated circuit of amended claim 21 includes an inductor on a substrate and a laminated film beside the inductor. The laminated film has a ferromagnetic substance layer and a metal layer covering the ferromagnetic substance layer to prevent diffusion of the ferromagnetic substance layer. Claim 26 includes the laminated film formed inside the

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¹ See *Fedeli*, column 3, line 50 to column 4, line 27 in conjunction with FIGS. 1 to 3.

inductor when viewed from a direction perpendicular to a surface of the substrate. Claim 27 includes the ferromagnetic substance layer is divided into a plurality of parts separated from one another when viewed from a direction perpendicular to a surface of the substrate.

As is well known, in proceedings before the Patent and Trademark Office, the examiner
5 bears the burden of establishing a prima facie case of obviousness based on the prior art.³

To establish a prima facie case of obviousness, a rejection must meet three basic criteria. First, there must be some suggestion or motivation to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all claim limitations.⁴

10 To address this rejection as pertaining to *Fedeli*, the arguments set forth with respect to amended claim 21 are incorporated herein by reference. Namely, *Fedeli* does not disclose or suggest a laminated film having a ferromagnetic substance layer and a metal layer covering the ferromagnetic substance layer to prevent diffusion of the ferromagnetic substance layer.

15 *Shiga* also does not show or suggest a metal layer covering the ferromagnetic substance layer to prevent diffusion of the ferromagnetic substance layer. *Shiga* discloses a core portion made of layers of high permeability magnetic material such as nickel separated by a dielectric thin film.⁵

Because the combination of references (*Fedeli* and *Shiga*) does not teach or suggest all the limitations of claim 27, the rejection is traversed.

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² See *Fedeli*, column 4, line 50 to column 5, line 6.

³ *Ex parte Obukowicz*, 27 USPQ 1063, 105 (B.P.A.I. 1992).

⁴ MPEP §2143.

⁵ See *Shiga* column 3, lines 6-11 and column 3, line 45 to column 4, line 6.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

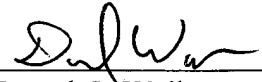
Claim 21 has been amended to include the metal layer covering the substance layer to prevent diffusion of the ferromagnetic substance layer. This does not include new matter. Support can be found in the specification on page 4, lines 11-15, as but one example. Claims 22, 24 and 29 have been re-written in independent form, incorporating the limitations of claim 21.

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The present claims 1-5, 21-27, and 29 are believed to be in allowable form. It is respectfully requested that the application be forwarded for allowance and issue.

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Respectfully Submitted,

 November 22, 2004

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